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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,648	09/09/2003	John D. Morris	5621-PI	3164
49459	7590	09/13/2006	EXAMINER	
NALCO COMPANY 1601 W. DIEHL ROAD NAPERVILLE, IL 60563-1198				DESAI, RITA J
		ART UNIT		PAPER NUMBER
				1625

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/658,648	MORRIS ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Rita J. Desai	1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 6/29/06.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 3-31 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/2004.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

Applicants have elected group I claims 1 and 2.

Even though applicants have elected with traverse they have not given why the groups are not independent and distinct nor why it would not be a burdensome search.

The examiner has made the restriction Final.

Claims 1 and 2 are being examined.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5986,030 Murray et al in view of Naphthalimide derivative JP 49043688 Noguchi et al.

Applicants compounds are salts of a fluorescent monomer as given by the formulae in claim 1.

Determination of the scope and content of the prior art (MPEP §2141.01)

USP 5,986,030 Murray et al teaches a water soluble polymer. The reference teaches the quaternary ammonium salt which is attached to a fluorescent molecule. The reference also teaches the use of the tagged polymers for sedimentation and solid/liquid separation. See whole document.

JP 49043688 Noguchi et al teaches a benz-isoquinoline ethanium compounds as fluorescent agents for fibers

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The compounds of Noguchi are similar to that of the applicants but they differ in that they have 2 substitutions with the quaternary ammonium group. The use of these compounds is also for fluorescent purposes.

Murray et al discloses the same process with a quaternary salt substituent on different fluor groups.

Finding of *prima facie* obviousness--rational and motivation (MPEP §2142-2413)

Murray teaches the process and the use of the quaternary group, and Noguchi et al teaches similar compound having the fluorescent properties, one of skill in the art would be motivated to use the compound Noguchi with the quaternary substituent for the process of Murray, especially as Murray teaches a variety of groups with one quaternary substituent. The motivation exists in the fact that the compounds have the same substituent and same property as those used by Murray and hence it would be obvious to make the modification on the compounds to obtain the compounds of the invention.

### *Conclusion*

Claims 1 and 2 are not allowable.

Claims 3-31 are withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rita J. Desai  
Primary Examiner  
Art Unit 1625

  
9/8/06

R.D.  
September 8, 2006